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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		01942-00007	
I hereby certify that this correspondence is being transmitted to the United States Postal Service electronically addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>January 22, 2007</u> Signature <u>[Signature]</u> Typed or printed name <u>Laurie Hall</u>		Application Number 10/006,796	Filed December 4, 2001
		First Named Inventor Eija M. Pirhonen	
		Art Unit 1618	Examiner Micah-Paul Young
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 34,628 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
		Signature <u>[Signature]</u> John P. Iwanicki Typed or printed name (617) 720-9600 Telephone number <u>January 22, 2007</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Eija Marjut Pirhonen, Timo Pohjonen, and)	Examiner:
Jan Nieuwenhuis)	Micah-Paul Young
)	
Serial No.: 10/006,796)	Art Unit: 1618
)	
Filed: December 4, 2001)	Conf. No.: 9843
)	
Title: BIODEGRADABLE IMPLANT AND)	
METHOD FOR MANUFACTURING ONE)	

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Alexandria, VA 22313-1450

REASONS IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW

Applicants respectfully request pre-appeal brief review for the following reasons.

In the present final Office Action dated September 22, 2006 and in view of the Advisory Action mailed December 19, 2006 responding to Applicants' Amendment and Response filed September 22, 2006, the Examiner has clearly erred by failing to identify where in Freeman the claim structural limitations of the implant having the plasticizer dispersed within the rigid matrix and a porous surface and a substantially nonporous core are found. The final office action also incorrectly rejects the amendment to the claims requiring a substantially nonporous core as being new matter. Finally, the final office action incorrectly relies on product-by-process considerations in rejecting the claims.

In the Response dated November 22, 2006 at pages 9-11, the Applicants reaffirm that the claimed implant requires the recited structure and composition of a rigid matrix and a plasticizer (N-methyl-2-pyrrolidone in particular for certain claims) dispersed within the rigid matrix and also requires a porous surface and a substantially nonporous core. Regarding the anticipation rejection of claims 1-4 and 6-8 based on Freeman at pages 3-4 of the present final office action of September 22, 2006, nowhere in the final office action does the Examiner state where Freeman discloses the presence of the claimed plasticizer dispersed within the rigid matrix. Instead, the Examiner has improperly ignored the clear presence of the claimed plasticizer dispersed within the rigid matrix, stating that it is not material to patentability. However, in an anticipation rejection, the Examiner cannot ignore claim limitations. The reference cited by the Examiner must teach each and every claim limitation expressly or inherently. The Examiner has identified no express teaching of the claimed plasticizer in Freeman and has stated no reasoning why the claimed plasticizer is necessarily present in Freeman. Accordingly, the Examiner's anticipation rejection of claims 1-4 and 6-8 based on Freeman is improper and should be withdrawn. Applicants note no other art rejections pending against claims 1-4 and 6-8.

Remaining claims 5 and 9-17 stand rejected at pages 4-5 of the final office action as being obvious over the combination of Freeman and Polson US 5,487,897. The Examiner notes in the final office action that Polson describes the use of N-methyl-2-pyrrolidone, but the Examiner does not identify in the final office action where Polson teaches NMP dispersed within a rigid matrix. Instead, Polson makes clear that the NMP is used as a solvent in an amount to form a liquid polymer solution. Col. 6 lines 45-58. NMP is not dispersed within a rigid matrix as claimed with the implant having a porous surface and a substantially nonporous core. See

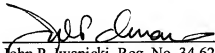
pages 11-13 of the Amendment and Response filed September 22, 2006. Further, Polson does not teach a porous surface with a substantially nonporous core. Polson, therefore, does not cure the deficiencies of Freeman. Accordingly, Freeman and Polson do not create a prima facie case of obviousness.

In response to the Examiner's rejection of claims 1-17 as including new matter as to the claimed substantially nonporous core, applicants have addressed that rejection at pages 6-9 of the Amendment and Response filed September 22, 2006. The final office action errs in not considering whether one of skill in the art following the teachings of the as-filed specification would understand that Applicants were in possession of the claimed invention at the time of filing. Clearly, one of skill in the art would understand this, and accordingly, the Examiner's rejection of the claims on new matter grounds is improper. *Ipsis verbis* recitation of claim language in the specification is not a prerequisite to meeting the written description requirement, and accordingly, a new matter rejection is improper when it is clear from the specification that the Applicants' were in possession of the claimed invention at the time of filing when specific examples recited in the specification are followed.

Based on the above, Applicants respectfully request a pre-appeal brief review.

Respectfully submitted,

Dated: January 22, 2007



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